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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,336	05/11/2001	Colin Hendrick	64482	7643
7590	10/19/2005		EXAMINER	
Norman H. Zivin Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			TRAIL, ALLYSON NEEL	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,336

Applicant(s)

HENDRICK, COLIN

Examiner

Allyson N. Trail

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/1/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the Amendment filed July 25, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 8-11, 13, 18-21, 23, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Surloff et al (2002/0196227).

In regards to claim 1, Surloff et al teach a system for managing digital right of digital content over a network (see figure 1). The system includes a data card (130 - figure 2). The smart card contains user information including digital rights information specific to a user, the data card has a memory component for enabling information to be stored within the data card (paragraph 0026). The system includes a data card reader (121 - figure 2), which is adapted to access the user information contained on the data card when the data card is in communication therewith. The system further includes (shown in figure 1), a data processor (114) in communication with the data card reader (120) via cable (132). Also shown in figure 1, the data processor (114) is adapted to be connected to the network ("computer network"). The data card (130) includes an

application program. The application program is configured to operate in conjunction with a universal language for creating and controlling digital rights in order to manage user rights of the digital content available on the network based on the digital rights information specific to the user which is contained on the data card. Paragraph 0069 clearly discloses these limitations: "Once the user is authenticated [via the data card], the user may press one of the previously described buttons on the mouse pad to access the Internet and purchase goods and services. In some embodiments, the content of the display (including advertisements) provided by the portal to the user, as well as the programming of the buttons on the mouse pad, may be tailored to the user based on information stored in the smart card."

Claims 11, 21 (through line 18 of claim 21), and 28 include the same limitations of claim 1, which are disclosed by Surloff et al above. The remainder of claim 21 is taught by below. See Surloff et al's teachings in regards to claims 8-10.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4-7, 12, 14-17, 22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surloff et al (2002/0196227) in view of Miron (6,401,239).

Surloff et al's teachings are discussed above. In regards to claims 6, 16, and 26, see Surloff et al's teachings of 3, 13, and 23. Surloff et al however fail to specifically

teach the digital content being in the form of software. Surloff et al additionally fail to teach the personal identification including a user name.

Miron teaches the following in regards to claims 2, 5, 7, 12, 15, 17, 22, 25, and 27:

"The present invention relates to downloading of electronic files from the Internet or other communication channels." (Col. 1, lines 5-6).

"Approximately 80% of all files transferred over the Internet are updated versions of previous files, for example, software updates, customer and supplier details, informational and statistical databases, books, manuals, encyclopedias, and more." (Col. 1, lines 20-24).

"It would be beneficial to have a system for sending products and interactive marketing material in a non-disruptive manner to targeted users who have expressed an interest in receiving them without the suppliers of the products and marketing material requiring a database of targeted users." (Col. 2, lines 21-26).

"One of the aspects of downloading ties is download for authorized clients only. For example, in an Internet software shop where the user selects software to download, the user is directed to a payment details form for providing account details such as a password or credit card details. Once the account details have been verified the user may download the software. If the account details are not verified, then the software may not be downloaded." (Col. 2, lines 27-34).

Miron teaches the following in regards to claims 4, 14, and 24:

“Moreover, in accordance with a preferred embodiment of the present invention, the client has a client identifier and the token is based upon the client identifier.” (Col. 4, lines 33-35).

Figure 8 shows the method of downloading digital content. The method includes providing account information, which may include a password, which may be interpreted as a user name.

In view of Miron's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Surloff et al's method of managing digital rights as disclosed above with Miron's teachings of managing rights to download specific products such as software. As discussed earlier, Surloff et al method manages user's access to websites for purchasing products or services. It is clear that software is a product, which may be purchased. Additionally, Surloff et al teaches above accessing client information from the smart card, therefore it would have been obvious to one of ordinary skill in the art to additionally require the user's name to be entered for verification as taught by Miron. One would be motivated to include the user's name for additional security.

Response to Arguments

6. Applicant's arguments, see pages 1-9, filed June 25, 2005, with respect to the rejection of claims 1, 3, 8-11, 13, 18-21, 23, and 28 being anticipated by Surloff et al and 2, 4-7, 12, 14-17, 22, and 24-27 being anticipated by Surloff et al in view of Miron have been fully considered however are not persuasive. The data card taught by Surloff et al includes an application program. As explained above, the data on the card

dictates certain sites as well as certain advertisements that are available to the user. By creating certain advertisements for the user, it is clear that the data card is used for creating and controlling digital rights. In order for the card to be able to communicate with the network, the application program must be configured to operate in conjunction with a universal language. The independent claims do not specifically state what universal language is used.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.trail@uspto.gov].

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All Internet e-mail communications will be made of record in the application file.

PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Allyson N. Trail
Patent Examiner
Art Unit 2876
October 6, 2005

Jared J. Fureman
JARED J. FUREMAN
PRIMARY EXAMINER